UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-106

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

FEB 10 2003

In re

: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 8, 15, 21 and 45 of the morning section and questions 8, 16 and 33 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On August 14, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been awarded any additional points. No credit has been awarded for morning questions 8, 15, 21 and 45 and afternoon questions 8, 16 and 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:
8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a *prima facie* showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (E) is correct. Petitioner contends that answer (D) is not a correct answer all the time, as whether answer (D) would or would not be in accordance with proper USPTO practices and procedures clearly depends on what assumptions one makes with regard to the filing date of Clark's German application (the foreign priority date of the application). Petitioner asserts that since one is instructed not to assume any

additional facts not presented in the questions, and the filing date of the German application is not provided, the question should be thrown out as the availability of the Jones patent under § 102(a) depends on the priority date of the Clark application.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (D) is not a correct answer all the time, as the availability of the Jones patent under § 102(a) depends on the priority date of the Clark application, this argument is simply not well-founded. In order to determine which section of 35 U.S.C. § 102 applies to a particular reference, the effective filing date of the application must be determined and compared with the date of the reference. If the application claims foreign priority under 35 U.S.C. § 119(a)-(d), the effective filing date is the filing date of the U.S. application (unless it is a continuation or divisional of one or more earlier U.S. applications and the requirements of 35 U.S.C. § 120 have been satisfied). The filing date of the foreign priority document is not the effective filing date, although the filing date of the foreign priority document may be used to overcome certain references. See MPEP § 706.02, § 706.02(b) and § 2136.05. In the instant scenario, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the effective filing date of the Clark application. Note that answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 15 reads as follows:
15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed *(cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (A) is correct. Petitioner contends that since Ben notified the examiner by phone of the death of Able, correspondence will now be held with Ben. Petitioner asserts that Ben can let Chris, who is a registered practitioner file a response to the Office action in a representative capacity under 37 CFR § 1.34(a). Petitioner points to MPEP § 714.01(c) which states: "A registered attorney or agent acting in a representative capacity under 37 CFR § 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402." Petitioner urges that this would entail no delays for Ben , as Chris is already familiar with the application and the Office action. Petitioner asserts that this would be in line with the general policy of the USPTO (after passage of the AIPA) to encourage applicants to act in an expedient manner during patent prosecution.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Ben can let Chris, who is a registered practitioner file a response to the Office action in a representative capacity under 37 CFR § 1.34(a), although this may be true, it appears that petitioner is reading too much into the answer (A), as this is not what answer (A) states. Specifically, answer (A) indicates "Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore Ben should not have any further contact with the Office and let Chris send in a proper response." Answer (A) nowhere includes discussion that "Chris, who is a registered practitioner may file a response to the Office action in a representative capacity under 37 CFR § 1.34(a)," as speculated by petitioner. Answer (A) is not the most correct answer because the power of a principal attorney will

be revoked or terminated by Able's death, and such a revocation or termination of the power of the principal attorney will also terminate Chris's associate power of attorney and Chris cannot continue representing Ben without a new power of attorney from Ben. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 21 reads as follows:
21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

(A) must issue a certificate of correction.

(B) must reprint the patent to correct the printing error.

(C) need not respond to Company X.

(D) should include Company X's notification in the patent file.

(E) must notify Company X of any USPTO decision not to correct the printing error.

21. The model answer: (C) is the most correct answer. *See* 37 C.F.R. § 1.322(a)(2)(i) ("There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section"). See MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. *See* 37 C.F.R. § 1.322(a)(2)(ii) ("Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office").

Petitioner argues that answer (A) is correct. Petitioner contends that although there "is no obligation on the Office to act on . . . a submission of information . . . by a third party, " 37 CFR § 1.3222(2)(i) *(sic),* the "Office will confirm to the party submitting such information that the Office has in fact received the information [if a stamped, self-addressed post card has been submitted]," MPEP § 1480, page 1400-64. Petitioner points out that the MPEP uses the "will confirm" rather than "may confirm" language above. Also, petitioner notes that the Office is "cognizant of the need for the public to have correct information about published patents and may . . . issue certificates of correction based on information supplied by third parties," MPEP § 1480, page 1400-63. Petitioner highlights the use of "cognizant of the need for the public" language, and asserts that this is an instance in which the Office needs to respond to the public (company X is part of the public) by issuing a certificate of correction.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that although there "is no obligation on the Office to act on . . . a submission of information . . . by a third party, " 37 CFR § 1.3222(2)(i) *(sic),* the "Office will confirm to the party submitting such information that the Office has in fact received the information [if a stamped, self-addressed post card has been submitted]," and that this is an instance in which the Office needs to respond to the public (company X is part of the public) by issuing a certificate of correction, this is simply not true. Answer (A) states that the USPTO "must issue a certificate of correction." This is incorrect, as it implies that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. Therefore, although the USPTO may issue a certificate of correction, the Office is not required to issue a certificate of correction, as this is up to the discretion of the USPTO Director. Note that although the Office will confirm to the party submitting such information that the Office has in fact received the information, by returning a stamped, self-addressed post card when one has been received with the submission of information, this does not mean that the USPTO is required to act on such submission. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 45 reads as follows:
45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art.

(B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).

(D) (A) and (C).

(E) (A), (B) and (C).

45. The model answer: (E). See MPEP § 706.02(b) page 700-23 (8 th ed.), under the heading "Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or

Patent." (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

Petitioner argues that answer (A) and (B) are correct answers. Petitioner contends that answers (A) and (B) are correct, citing MPEP § 706.02(b), page 700-23. Petitioner contends that answer (C) ambiguously states in part that an affidavit or declaration under 37 CFR § 1.131 showing prior invention would be appropriate if the reference is not a U.S. patent that claims an obvious variation of the subject matter in the rejected claims. Petitioner asserts that MPEP § 706.02(b)(D), page 700-23, merely states that when "the claims of the reference and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR § 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate . . . If there is no common assignee or inventor and the rejection under 35 USC § 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared." Petitioner notes that the question provides no information on whether 35 USC § 102(e) is the only possible rejection or whether there is a common assignee or inventor, and asserts that answer (C) clearly misstates the rule 37 CFR § 1.131.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (C) ambiguously states in part that an affidavit or declaration under 37 CFR § 1.131 showing prior invention would be appropriate if the reference is not a U.S. patent that claims an obvious variation of the subject matter in the rejected claims, and petitioner's assertion that answer (C) clearly misstates 37 CFR § 1.131, this is simply not true. Answer (C) states "Filing an affidavit or declaration under 37 CFR § 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s)" (emphasis added). Note MPEP § 706.02(b), page 700-23, paragraph entitled "A rejection based on 35 USC § 102(e) can be overcome by:. (D) Filing an affidavit or declaration under 37 CFR § 1.131 showing prior invention if the reference is not a U.S. patent . . . claiming the same patentable invention as defined in 37 CFR § 1.601(n). See MPEP § 715 for more information on 37 CFR § 1.131 affidavits. When the claims of the reference and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR § 1.131 is not an acceptable method of overcoming the rejection." Therefore, the affidavit or declaration under 37 CFR § 1.131may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e) if the reference is not a U.S. patent claiming the same invention or claiming an obvious variation of the subject matter in the rejected claim(s), as stated in Answer (C). Accordingly, model answer (E) is correct and petitioner's answer is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 8 reads as follows:
8. A grant of small entity status entitles an applicant to which of the following?

(A) Applicant can pay a fee to file an information disclosure statement pursuant to 37 CFR 1.97(c) that is less than the fee required to be paid by other than a small entity.

(B) Applicant can file a Continued Prosecution Application ("CPA") using a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the CPA.

(C) Applicant can pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity.

(D) After issuance of a non- final first action, but before the close of the prosecution in a patent application, applicant may properly file a Request for Continued Examination and pay a fee that is less than the fee required to be paid by other than a small entity.

(E) None of the above.

8. The model answer: (C) is the correct answer. 35 U.S.C. § 41(h), 37 C.F.R. §§ 1.17(l) and 1.27(b). (A) is incorrect because 37 C.F.R. § 1.17(p) provides for only one fee for filing an IDS all parties must pay that fee. There is no support in 37 C.F.R. § 1.17(p) for a small entity paying a reduced fee for filing an IDS. (B) is incorrect because it is inconsistent with 37 C.F.R. § 1.8(a)(2)(i)(A). (D) is incorrect because it is inconsistent with 37 C.F.R. § 1.114(a), inasmuch as prosecution is not closed. (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that the question refers to "a grant of small entity status," and submits that no such grant currently exists, is needed, or required in any shape or form by applicant. Petitioner asserts that small entity status is not granted by the USPTO, rather, applicant is entitled by law to self-certify its small entity status before the USPTO after "a complete and thorough investigation of all facts and circumstances," therefore, the question is misleading, inaccurate and should be thrown out in its entirety.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that submits that small entity status is not granted by the USPTO, rather, applicant is entitled by law to self-certify its small entity status before the USPTO after "a complete and thorough investigation of all facts and circumstances," it should be noted that 37 CFR § 1.27(b) states: "A small entity . . . who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which

entitlement to small entity status was asserted." Therefore, in this question "grant" is intended to express that the applicant properly established entitlement to small entity status and has been accorded small entity status by the Office in the instant application, which entitles applicant to pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:
16. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3: Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C. Claim 2. The method of claim 1, further characterized by the step of D. Claim 3. The Ethernet cable as in any one of the preceding claims. In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

(A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."

(B) Cancel Claim 3. Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C." Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."

(C) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."

(D) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."

(E) Cancel Claim 3.

16. The model answer: (B) is the most correct answer. The cancellation of Claim 3 overcomes the examiner's objection. The addition of Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 C.F.R. § 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (C) alone is not the most correct answer because even though canceling Claim 3 will overcome the objection and provides protection for the Ethernet cable made by the process comprising the steps A, B

and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the objection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C. Answer (E) alone is incorrect because, even though canceling the claim will overcome the objection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (B) overcomes the examiner's objection, but does not provide the client with the broadest patent protection due to the introduction of a new independent claim 5 which is narrower in scope than new independent claim 4, i.e., the overall scope of claims 1-2, 4-5 inclusive, would be narrower, for example, than the overall scope of claims 1-2, 4 inclusive, taken alone. Petitioner asserts that answer (C) overcomes the examiner's objection and provides the client with the broadest patent protection due to the introduction of a new broad independent claim 4, and the omission of a new product by process claim to cover the subject matter of claim 2. Petitioner maintains that clearly the overall scope of claims 1-2, 4 (of answer (C)) is broader than the overall scope of claims 1-2, 4-5 (of answer (B)).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (B) overcomes the examiner's objection, but does not provide the client with the broadest patent protection due to the introduction of a new independent claim 5, which is narrower in scope than new independent claim 4, petitioner is apparently missing the point of this question. Claim 3 was intended to be a product by process claim, wherein the product of claim 3 is made by the process of claim 1, or the process of claim 2. But, claim 3 was not properly drafted, and hence was objected to as being an improper dependent claim and the examiner required cancellation of the claim. Therefore, whether new independent claim 5 is narrower in scope than new independent claim 4 is irrelevant to the issue at hand. The task at hand is to cancel claim 3 and present new claims drafted to provide the scope of claim coverage that was intended to be covered by improper claim 3. Therefore, although answer (C) may be a correct answer, it is not the most correct answer, because although canceling Claim 3 will overcome the objection and provide protection for the Ethernet cable made by the process comprising the steps A, B and C, it will leave the application without a claim to the Ethernet cable made by the process comprising the steps of A, B, C, and D. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:
33. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

(A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

(B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.

(C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.

(D) (A) and (C).

(E) None of the above.

33. The model answer: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that MC Motors could have filed their U.S. patent application (in August 2000) listing Eve as a sole true inventor, in which case a § 102(f) patent bar would not apply and answer (C) would be correct. Petitioner argues that if answers (C) and (A) are correct, then answer (D) must be the most correct answer. Petitioner asserts that in view of the incomplete factual information that answer (D) is the most correct answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that MC Motors could have filed their U.S. patent application (in August 2000) listing Eve as a sole true inventor, in which case a § 102(f) patent bar would not apply and answer (C) would be correct, although such may have

been a possibility, this is not part of the fact pattern provided. It should be noted that the instructions for the examination directed petitioner as follows: "Do not assume any additional facts not presented in the questions." Petitioner has apparently improperly assumed that MC Motors listed Eve as a sole true inventor, in which case a 102(f) patent bar would not apply and answer (C) would be correct. However, such assumption is inappropriate, and not part of the instant fact pattern. Note that answer (C) is incorrect because MC Motors personnel were not the true inventors, and therefore, the misappropriation of Eve's reverse automobile heating system is within the jurisdiction of the USPTO pursuant to 35 U.S.C. § 102(f). See MPEP § 706.02(g), and § § 2137-2137.02. Accordingly, model answer (A) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy